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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/788,732      | 02/27/2004  | Lee D. Saathoff      | EI-7624             | 6113             |

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| EXAMINER |
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GOLOBOY, JAMES C

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| ART UNIT | PAPER NUMBER |
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1714

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE  | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS                               | 04/05/2007 | PAPER         |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/788,732

Applicant(s)

SAATHOFF ET AL.

Examiner

James Goloboy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/27/2007</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. Claims 1-3, 5-9, and 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Izumi (U.S. Pat. No. 3,720,615).

This rejection is adequately set forth in paragraph 7 of the office action mailed 10/12/06.

***Claim Rejections - 35 USC § 103***

2. Claims 1-4, 6-7, and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lowe (U.S. Pat. No. 4,177,153).

Lowe, in the abstract, discloses a lubricant composition comprising a tertiary amine. In column 6 line 2 Lowe discloses that the composition may further comprise an ashless dispersant, including a succinimide, as recited in Claim 1(b) and 12. In column 4 lines 9-17 Lowe discloses that the tertiary amines have three alkyl R substituents which may be saturated and straight chain (aliphatic). Lowe further discloses that at least one of the R groups is preferably a C<sub>11</sub>-C<sub>25</sub> alkyl, falling within the ranges recited in Claims 1, 6, and 7 (as the number of carbons must be an integer, 11 clearly meets the limitation of "about 12" in Claim 7), with the remaining R groups C<sub>1</sub>-C<sub>5</sub> alkyls,

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anticipating the range recited for the shorter-chain group of Claim 1 (5 meets the limitation of “about 4”).

In column 5 lines 10-35, Lowe discloses base oils suitable for the lubricant composition, including mineral oils (naphthenic base, paraffin base), as recited in Claims 2 and 3, synthetic oils, as recited in Claim 3, esters (lines 20-32), as recited in Claim 4, and oils derived from a Fischer-Tropsch process (“oils derived from coal products”, lines 13-14), as recited in Claim 4.

In columns 6-7 (Table I), Lowe discloses lubricant compositions comprising 0.1% by weight of the tertiary amine, falling within the range recited in Claim 9. From column 5 line 43 through column 6 line 14, Lowe discloses additional additives for the lubricant composition, including a corrosion (rust) inhibitor, an antifoam agent, and an antiwear agent, as recited in Claim 11. In column 3 line 13 Lowe further discloses that an antioxidant, as recited in Claim 11, may also be used in the composition.

The difference between Lowe and the currently presented claims is that Lowe does not explicitly disclose a tertiary amine with two long carbon chains. However, given the limited possible choices for “at least one” long carbon chain (one, two or three), it would have been obvious to one of ordinary skill that Lowe considers tertiary amines with two long carbon chains to be suitable additives. While Lowe does not exemplify a tertiary amine with two long carbon chains, this does not negate a finding of obviousness under 35 USC 103 since a preferred embodiment such as an example is not controlling. Rather, all disclosures “including unpreferred embodiments” must be considered. *In re Lamberti* 192 USPQ 278, 280 (CCPA 1976) citing *In re Mills* 176

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USPQ 196 (CCPA 1972). Additionally, it is noted that Lowe does not explicitly prefer amines with one or three long carbon chains.

Lowe, in column 2 lines 67-68, discloses that the tertiary amine is present in the fluid in the amount of 0.001 to 5% by weight, encompassing the range recited in Claim 10. Case law holds that "[ A ] prior art reference that discloses a range encompassing a somewhat narrower claimed range is sufficient to establish a *prima facie* case of obviousness." *In re Peterson*, 315 F.3d 1325, 1330, 65 USPQ2d 1379, 1382-83 (Fed. Cir. 2003). Therefore, Claim 10 is rendered obvious.

3. Claims 13, 15-16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lowe in view of Ohtani (U.S. Pat. No. 5,344,579).

The rejection is adequately set forth in paragraph 11 of the office action mailed 10/12/06.

4. Claims 14, 17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lowe in view of Watts (U.S. Pat. No. 6,225,266).

The rejection is adequately set forth in paragraph 12 of the office action mailed 10/12/06.

5. Claims 20-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lowe in view of Papay (U.S. Pat. No. 4,795,583) and Field (U.S. Pat. No. 6,844,301).

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The rejection is adequately set forth in paragraph 13 of the office action mailed 10/12/06.

6. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lowe in view of Papay and Field as applied to claim 20 above, and further in view of Ohtani.

The rejection is adequately set forth in paragraph 14 of the office action mailed 10/12/06.

7. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lowe in view of Papay and Field as applied to claim 20 above, and further in view of Watts.

The rejection is adequately set forth in paragraph 15 of the office action mailed 10/12/06.

### **Response to Arguments**

8. Applicant's arguments with respect to the rejections of claims 1-4, 6-7, 9, and 11-12 as anticipated by Lowe have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues that Izumi does not anticipate the currently presented claims for several reasons:

- i) Izumi does not disclose compositions devoid of an acid or partial ester
- ii) Any tertiary amine appears to be suitable for the purposes of rust prevention

With respect to i), the open-ended "comprising" language of claim 1 allows for the composition to contain additional elements, such as the acid or partial ester of Izumi.

With respect to ii), Izumi discloses a specific amine meeting the limitations of claim 1 that is suitable for addition to a composition comprising a base oil and an ashless dispersant. A motivation for selecting the composition is not required for a rejection under 35 USC 102, as the claimed composition is not novel.

Applicant additionally argues that there is no teaching, suggestion or disclosure in Lowe for providing a composition in order to provide the advantages of the current claims (improved friction durability). However, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). See also MPEP 2145(II).

While the rejections of claim 20 under 35 USC 112 have been withdrawn in light of applicant's amendment, it is noted that applicant's argument that a power transmission fluid "by definition" contains friction modifiers is incorrect in light of the specification. On pages 13-14 of the specification, which includes the section applicant refers to, friction modifiers are clearly disclosed as an *optional* component of the power transmission fluid.

It is noted that Claim 1 refers to a "power transmission fluid composition", which is an intended use recitation, and does not impose any structural limitations on the compositions. According to MPEP 2111.02, "If the body of a claim fully and intrinsically

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sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999)."

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is 571-272-2476. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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